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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

96502-0381-00000

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Signature _____

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Application Number

10/035,580

Filed

12/28/2001

First Named Inventor

Guy L. Steele, JR.

Art Unit

2193

Examiner

Chat C. Do

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

attorney or agent of record.
Registration number 56,249

Nathan A. Sloan

Signature

Nathan A. Sloan

Typed or printed name

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Telephone number

attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

9/30/05

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**EXPEDITED PROCEDURE REQUESTED
EXAMINING GROUP 2193
PATENT
Customer No. 22,852
Attorney Docket No. 06502.0381-00**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Guy L. STEELE, Jr.) Group Art Unit: 2193
Application No.: 10/035,580) Examiner: Do, Chat C.
Filed: December 28, 2001) Confirmation No.: 2889
For: FLOATING POINT MULTIPLIER)
WITH EMBEDDED STATUS)
INFORMATION)

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant requests a pre-appeal brief review of the rejections in the Office Action mailed April 8, 2005. This Request is being filed concurrently with a Notice of Appeal, in accordance with the Official Gazette Notice of July 12, 2005.

This Pre-Appeal Brief request for review follows the Examiner's Advisory Action mailed June 30, 2005.

Remarks begin on page 2 of this paper.

REMARKS

Claims 1-40 remain pending, with claims 1-40 being the subject of this Pre-Appeal Brief request for review. In the Final Office Action, the Examiner rejected claims 1-40 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,995,991 to Huang et al. ("Huang"). The Examiner also provisionally rejected claims 1-6, 8-19, 21-32, and 34-40 under obviousness-type double patenting as being unpatentable over claims 1-37 in copending Application No. 10/035,584 ("584") in view of U.S. Patent No. 5,065,352 to Nakano ("Nakano").¹

I. The rejection of claims 1-40 under 35 U.S.C. § 102(b) as being anticipated by *Huang* is improper.

The Examiner's rejection contains clear errors and omits essential elements necessary to establish anticipation with respect to claims 1-40 based on *Huang*. *Huang* does not teach or suggest each and every element of Applicant's claims.

Claim 1 recites a combination including, for example,

an analyzer circuit configured to determine a first status of a first floating point operand and a second status of a second floating point operand based upon data within the first floating point operand and data within the second floating point operand respectively; and ...

a resulting status embedded within the resulting floating point operand

(emphasis added).

The Examiner appears to assert that *Huang*'s register 116 (Fig. 4) constitutes the claimed "operand." This is clearly wrong.

Huang specifically distinguishes between a register and an operand, stating "each of the registers 116 and 118 has an operand . . . portion 116-1 and 118-1." (*Huang*, col. 6,

¹ Pending the withdrawal of the rejections under 35 U.S.C. § 102(b), Applicant will respond to the double patenting rejection as set forth in M.P.E.P. § 804(I)(B) or § 804.02. Applicant does not request review of these rejections by the Pre-Appeal Brief review board.

line 66- col. 7, line 1). Moreover, “**operands X and Y [are] stored in operand portions 116-1 and 118-1 of registers 116 and 118.**” (*Huang*, col. 7, lines 8-10). Even assuming that tag values *x_tag* and *y_tag* correspond to the claimed “data” and “status,” (which Applicant does not concede) the Examiner’s contention that *Huang*’s register 116 containing *x_tag* 116-2 constitutes the claimed “data within the … operand” and “resulting status embedded within the resulting … operand” is clearly contradicted by *Huang*. See, e.g., *RFR* at pp. 3-4.

Structures such as those taught by *Huang* were acknowledged in the Background section of Applicant’s specification, which states “conditions are typically represented by flags that are stored in the floating point status register” (paragraph 026). Claim 1 specifically distinguishes over such structures, calling for “data within the … operand” and a “resulting status embedded within the resulting … operand.” See, e.g., Fig. 2, paragraph 045, and paragraph 046 of Applicant’s specification.

Accordingly, the Examiner’s position that *Huang*’s register 116 constitutes an “operand,” as recited by the claims, is a clear error. The separate operand 116-1 and separate tag value 116-2 of *Huang* do not constitute a teaching or suggestion of “data within the … operand” or a “resulting status embedded within the resulting … operand,” as recited by claims 1, 15, and 28 and required by dependent claims 2-14, 16-27, and 29-40.

Since *Huang* fails to teach each and every element of the claims, *Huang* cannot anticipate claims 1-40. Applicant requests the board of examiners to allow these claims.

Customer No. 22,852
Attorney Docket No. 06502.0381-00
Application No. 10/035,580

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: September 30, 2005

By: Nathan A. Sloan
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